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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,348	01/04/2005	Toru Ikuta	2224-0237PUS1	5464
2292 7590 02/22/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
KNABLE, GEOFFREY L				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
02/22/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

### Office Action Summary

**Application No.**

10/520,348

**Applicant(s)**

IKUTA, TORU

**Examiner**

Geoffrey L. Knable

**Art Unit**

1791

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) 1, 3 and 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 5, 6, 8 and 12-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 3 and 9-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 7/26/2007.
3. Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection is maintained for the same reasons set forth in the last office action. As support for the claim 5 requirement, applicant has pointed to page 75, lines 8-15 of the specification. It is not seen however where these lines define that the reinforcing layer also is an adhesive layer as defined in claim 5. Note again that the original disclosure describes the resin member as *either* a reinforcing layer or an adhesive - e.g. see page 10, lines 19-21 which recites that "[t]he resin member may comprise a reinforcing layer of the tire, or may form an adhesive layer to at least one rubber layer or rubber member constituting the tire." It is not seen where the original disclosure describes the reinforcing layer forming an adhesive layer. This therefore is still considered to represent subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

inventor(s), at the time the application was filed, had possession of the claimed invention, i.e. it is new matter.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In addition to the description/new matter issue noted above, the scope of the claim 5 requirement is also still indefinite as it is not clear how the resin member can both form at least part of the reinforcing layer and be an adhesive for bonding. In response to this rejection, it is argued that the reinforcing layer itself may be an adhesive. Following this reading, it would then be uncertain what is being added and/or excluded by the claim 5 requirement given that claim 2 already requires that the reinforcing layer is bonded to the rubber - the scope of claim 5 is therefore indefinite as it is not clear what is required beyond what is already defined claim 2.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Literal antecedent in the specification for the new claim requirement for a "plate- or sheet-like polyamide reinforcing layer formed on the internal surface of the tire body" should be provided.

6. Claims 2, 5, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa et al. (US 6,415,840) taken in view of at least one of [Weaver et al. (US 4,146,513) and Rongone (US 4,063,979)].

This rejection is maintained for substantially the same reasons as set forth in the last office action. With respect to the new requirement for a plate or sheet-like polyamide reinforcing layer, the reinforcing layer of Nishikawa et al. (e.g. 8a/8b in fig. 1) is in a sheet form and comprises polyamide (since it can include polyamide fibers) - the claims require nothing more.

7. Claims 2, 5, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boussu et al. (US 2,884,040) taken in view of at least one of [Weaver et al. (US 4,146,513) and Rongone (US 4,063,979)] **or** at least one of [Freytag et al. (US 3,596,696) and Buckwalter et al. (US 2,927,051)].

This rejection is maintained for substantially the same reasons as set forth in the last office action. With respect to the new requirement for a plate or sheet-like polyamide reinforcing layer, the reinforcing layer of Boussu et al. (7) is in a sheet form and comprises polyamide (since it can include polyamide cables or be a polyamide strip) - the claims require nothing more.

8. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over (1) [Nishikawa et al. (US 6,415,840) taken in view of at least one of [Weaver et al. (US 4,146,513) and Rongone (US 4,063,979)]] **or** (2) [Boussu et al. (US 2,884,040) taken in view of at least one of [Weaver et al. (US 4,146,513) and Rongone (US 4,063,979)] **or** at least one of [Freytag et al. (US 3,596,696) and Buckwalter et al. (US 2,927,051)]] as applied to claim 2 above, and further in view of the Kirk Othmer article entitled "Rubber Chemicals" as applied in the last office action.

9. Applicant's arguments filed 10/19/2009 have been fully considered but they are not persuasive.

The arguments with respect to the 112 first and second paragraph rejections of claim 5 have been treated within the statement of rejection above.

With respect to the prior art rejections, it is argued that the references relate to polyamide fiber or textile and do not relate to a plate-like polyamide layer. However, the claimed reference to a "plate- or sheet-like polyamide reinforcing layer" does not exclude or define over a plate/sheet reinforcing layer that comprises polyamide; i.e. the term plate/sheet modifies the configuration of the *layer*, not the polyamide, and the claim does not require that the layer "consist of" polyamide. Thus, a sheet-like layer that comprises/includes polyamide therein satisfies this requirement of the present claims.

Additionally, it is again also stressed that Boussu et al. is not limited to polyamide fibers/cables as it discloses that the reinforcing layer (7) can also be formed as a *strip* of nylon (esp. col. 3, lines 34-37) which would also be consistent with the claimed plate/sheet-like layer.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Geoffrey L. Knable/  
Primary Examiner, Art Unit 1791

G. Knable  
February 12, 2010